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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
ROGERS, JAMES WILLIAM	

ART UNIT	PAPER NUMBER
1618	

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/735,156	LION, BERTRAND	
	Examiner	Art Unit	
	James W. Rogers	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) *5-9 and 23-27* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 10-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *04/19/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of group I claims 1-4 and 10-22 in the reply filed on 05/18/2006 is acknowledged.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3-4,10-20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Sebag et al. (US 6,403,106 B1).

Sebag teaches cosmetic compositions comprising copolymers with a rigid backbone (can comprise methyl (meth)acrylate) within the MW range specified by applicants and grafted with macromonomers (including polyethylene/polybutylene copolymer) within the weight % and MW range specified by applicants, the carrier can comprise only cosmetically compatible organic solvents thus meeting the limitation of a non-aqueous non-silicone organic medium. See col 1 lin 9-14, col 2 lin 50-col 4 lin 36 and col 6 lin 53-col 7 lin 11. Regarding claim 22 the limitation that the solids or dry content is between 4-70 % is met because Sebag teaches the concentration of the graft copolymers (considered by examiner to be solid content) is between 0.1-50 percent, within the range specified by applicants. See col 6 lin 45-49.

Claims 1,3-4,10-15,17-20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Mougin et al. (US 6,113,882).

Mougin teaches cosmetic compositions comprising copolymers (including methyl (meth)acrylate) within the MW range specified by applicants and grafted with macromonomers within the weight % and MW range specified by applicants, the carrier can comprise only cosmetically compatible organic solvents thus meeting the limitation of a non-aqueous non-silicone organic medium. See col 1 lin 7-12, col 2 lin 56-col 4 lin 32 and col 6 lin 49- col 7 lin 13. Regarding claim 22 the limitation that the solids or dry content is between 4-70 % is met because Sebag teaches the concentration of the graft copolymers (considered by examiner to be solid content) is between 0.1-50 percent, within the range specified by applicants. See col 6 lin 40-45.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4 and 10-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sebag et al. (US 6,403,106 B1).

Sebag is disclosed above. The Sebag patent does not specially disclose that the carrier or adjuvants listed in the patent are at least 50% of the weight of the dispersion nor does it give the Hanson solubility space for the solvents. It is obvious however that since the graft copolymer of the patent can comprise anywhere between 0.1-50% of the

dispersion the carrier and adjuvants would obviously comprise the rest which would be at least 50%. Regarding claim 2 the limitation for the Hanson solubility space equal to 17 $(MPA)^{1/2}$ is met, it is obvious that since the organic solvents are cosmetically compatible it would encompass solvents with the above parameter since the applicants dispersion is also to be used in a cosmetic formulation, the burden is shifted to the applicant to show that the solvents listed in the Sebag patent would not have solubility parameters as listed in claim 2. Besides the above the Sebag patent discloses several adjuvants such as fatty oils (including vegetable oil) that could have the above solubility parameter especially when the organic solvent is mixed with the oils or waxes listed. Regarding claim 21 the Sebag patent is silent on the size of the particles of the graft copolymer but it is inherent that if the patent used an organic medium that is non-polar it would form micelles within the specified range listed since the graft copolymers are the same they would aggregate and form particles in the same way and would have the exact same size.

Claims 1-4 and 10-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mougin et al. (US 6,113,882).

Mougin is disclosed above. The Mougin patent does not specially disclose that the carrier or adjuvants listed in the patent are at least 50% of the weight of the dispersion nor does it give the Hanson solubility space for the solvents. It is obvious however that since the graft copolymer of the patent can comprise anywhere between 0.1-50% of the dispersion the carrier and adjuvants would obviously comprise the rest which could be at least 50%. Regarding claim 2 the limitation for the Hanson solubility

space equal to 17 $(MPA)^{1/2}$ is met, it is obvious that since the organic solvents are cosmetically compatible it would encompass solvents with the above parameter since the applicants dispersion is also to be used in a cosmetic formulation, the burden is shifted to the applicant to show that the solvents listed in the Mougin patent would not have solubility parameters as listed in claim 2. Besides the above the Mougin patent discloses several adjuvants such as fatty oils (including vegetable oil) that could have the above solubility parameter especially when the organic solvent is mixed with the oils or waxes listed. Regarding claim 16 the Mougin patent does not specifically list polyethylene/polybutylene copolymer as a macromonomer, however this is an obvious variant of the macromonomers disclosed in the patent because it states that the macromonomer is intended to describe any oligomer comprising one end containing an ethylenic unsaturation capable of polymerization. See col 2 lin 39-47. Regarding claim 21 the Mougin patent is silent on the size of the particles of the graft copolymer but it is inherent that if the patent used an organic medium that is non-polar it would form micelles within the specified range listed since the graft copolymers are the same they would aggregate and form particles in the same way and would have the exact same size.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 and 10-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,2,6,7,10,11,13,14,16,17,24,25, 26,30,31,32 of U.S. Patent No. 6,403,106 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-4 and 10-22 are generic to all that is recited in claims 1,2,6,7,10,11,13,14,16,17,24,25,26,30,31,32 of U.S. Patent No. 6,403,106 B1. That is, claims 1,2,6,7,7,10,11,13,14,16,17,24,25,26, 30,31,32 of U.S. Patent No. 6,403,106 B1 falls entirely within the scope of claims 1-4 and 10-22 or in other words, claims 1-4 and 10-22 are anticipated by claims 1,2,6,7,10,11,13,14,16,17,24,25,26,30,31,32 of U.S. Patent No. 6,403,106 B1. Specifically both disclose dispersions in non-aqueous non-silicone organic mediums comprised of at least one acrylic monomer (including methyl (meth)acrylate) and one carbon based macromolecule (including polyethylene/ polybutylene).

Claims 1-4,10-15 and 17-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12,15,22-31 of U.S. Patent No. 6,113,882. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-4,10-15 and 17-22 are generic to all that is recited in claims 1-12,15,22-31 of U.S. Patent No. 6,113,882. That is, claims 1-12,15,22-31 of U.S. Patent No. 6,113,882 falls entirely within the scope of claims 1-4,10-15 and 17-22 or in other words, claims 1-4,10-15 and 17-22 are anticipated by claims 1-12,15,22-31 of U.S. Patent No. 6,113,882. Specifically both disclose dispersions in non-aqueous non-silicone organic mediums comprised of at least one acrylic monomer (including methyl (meth)acrylate) and one carbon based macromolecule.

Conclusion

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER